IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:	)	Group Art Unit No.: 2625
	)	
Osama Elkady, et al.	)	Examiner: McLean, Neil R.
	)	
Serial No.: 10/733,102	)	Confirmation No.: 9183
	)	
Filed on: December 10, 2003	)	
	)	
For: GENERATING MERGED DOCUMENTS	)	
	)	
	)	
	)	

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REPLY BRIEF

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed on January 21, 2011 (hereinafter "Examiner's Answer").

I. STATUS OF CLAIMS

Claims 1-29 and 31 are pending in this application, were finally rejected in the Office Action mailed on May 11, 2010 (hereinafter "Office Action") and are the subject of this appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-29 and 31 stand finally-rejected under 35 U.S.C. § 103(a) as being anticipated by Barry et al., U.S. Patent No. 7,099,027 (hereinafter "Barry") in view of Schwier et al., U.S. Patent No. 7,202,972 (hereinafter "Schwier").

III.   ARGUMENTS

The remarks below are made in response to Examiner's arguments in the Examiner's Answer. These remarks stand in addition to those made in the Appeal Brief, each of which remains valid in view of the Examiner's Answer. As explained in the remarks below, the rejections of record are based on numerous factual and legal errors. For at least these reasons, Claims 1-29 and 31 are valid over the cited references.

A.   *The Examiner's Answer incorrectly alleges that Applicants acknowledge that Barry describes a request within the meaning of Claim 1.*

As Applicants explained on pages 7–8 of the Appeal Brief, *Barry* does not describe a "request" within the meaning of Claim 1. The Examiner's Answer nonetheless alleges on page 13 that "Applicant appears to be tacitly acknowledging this limitation in the Barry reference" because Applicants mentioned that *Barry*'s "alleged merge utility responds to a request to merge." The allegation is incorrect.

The Examiner appears to ignore or not understand certain features of the "request" recited in Claim 1. The recited request is not simply a request to merge. The recited request is "a request to merge a first merge document in a merge format with a second document in an original format." Applicants acknowledge the existence of, in *Barry*, a request to merge. However, for the reasons already explained by Applicants in the Appeal Brief, *Barry* does not teach or suggest "a request to merge a first merge document in a merge format with a second document in an original format," as recited in Claim 1.

B.   *The Examiner's Answer incorrectly suggests that summing Junction 804 implies a request to merge a document in a merge format with a document in another format*

The Examiner's Answer appears to allege on page 13 that *Barry* implicitly receives "a request to merge a first merge document in a merge format with a second document" in a format that requires conversion because *Barry* at col. 13, lines 15–18, states "summing junction 804 is a conversion operation." Because summing junction 804 "is a conversion operation," the

Examiner's Answer appears to allege, it follows that one input is in a merge format while another input is in a format that needs to be converted.

The allegation is incorrect. FIG. 8 clearly shows that both inputs to summing junction 804 are in the same PDL format. Moreover, when *Barry* states that summing junction 804 is a conversion operation, *Barry* does not mean that summing junction 804 involves a conversion from one format to another. In fact, *Barry* teaches exactly the opposite in col. 13, lines 26–30:

> "In any event, there is provided on the output of summing block 804 a converted PDLin job in the same PDL format. If the job were originally in Postscript, it would still be in PostScript, albeit with the new information merged therein."

Clearly, the "conversion operation" constituted by summing junction 804 is not a conversion of document formats. *Barry* at col. 13, lines 17–18. Since summing junction 804 involves no conversion of formats, summing junction 804 cannot involve a request to merge a document in a merge format with a document in another format that requires conversion.

Nor would it be obvious to modify *Barry* to receive a request that include one document in a merge format and one document in an original format, for at least the reason that the above cited portions of *Barry* clearly teach against converting the input documents to a different format.

Thus, for this and other reasons explained by Applicants in the Appeal Brief, *Barry* would not, in combination with *Schwier* or any other reference, teach or suggest "a request to merge a first merge document in a merge format with a second document in an original format," as recited in Claim 1.

C. *The Examiner's Answer incorrectly states that* **Schwier** *describes a merge utility that converts one of its input documents*

The Examiner's Answer further alleges on page 14 that *Schwier* describes a merge utility that "takes a document in an original format and converts that document into a format that is 'merge ready i.e. PCL.'" The allegation is erroneous. While *Schwier* describes components capable of merging documents (applications 10 and printer 7), these components do not convert any documents. Meanwhile, the components that do convert documents in *Schwier*, such as PCL

converter 18, clearly do not merge a document in a merge format with a document in an original format. *See Appeal Brief* at 8-9.

> **D.** *The Examiner's Answer incorrectly alleges that* **Schwier** *describes a merge utility passing a set of conversion instructions to a document authoring application*

The Examiner's Answer appears to allege on page 15 that *Schwier* at col. 4, lines 15–30 describes "passing [a] set of conversion instructions from the merge utility to the first document authoring application . . . [that] cause the first document authoring application to generate the second merge document based on said set of conversion instructions," on account of "the logical linking of reference data and parameters described" therein. The allegation is incorrect. The relied upon passage of *Schwier* merely shows that a user of a document authoring application may instruct the application to insert data into an EMF document that, when interpreted by a convertor unit, causes the convertor unit to incorporate a non-variable EMF data stream into the EMF document. *Schwier* at col. 4, lines 24-30. The passage contains no description of a merge utility passing a set of conversion instructions back to a document authoring application.

> **E.** *The Examiner's Answer incorrectly alleges that* **Schwier** *describes a merge request that "contains information about the first document authoring application"*

The Examiner's Answer on page 16 alleges that *Schwier* at col. 4, lines 25–26, teaches that the request of Claim 1, as discussed above, "contains information about the first document authoring application." The allegation is erroneous. Aside from the fact that *Schwier* does not teach the request of Claim 1, there is no merge request in *Schwier* that contains "information about the first document authoring application." The cited passage merely states that, when creating a document, a user may insert a reference to another document. No merge request is involved in this process. Even if the documents could be considered an inherent part of a some subsequently implied merge request, this passage of *Schwier* states only that the documents contain reference data about another document, not that the documents "contain information about the first document authoring application."

F.   ***The Examiner failed to respond to Applicants' arguments concerning other***
dependent claims

Applicants presented separate and distinct arguments with respect to a number of other dependent claims on pages 12-14. The Examiner lists grounds of rejections for these claims in section (9) of the Examiner's Answer, but provides no response to the issues raised by Applicants in the Appeal Brief with regard to the argued dependent claims. In view of the guidelines set forth in MPEP 1207.02, Applicants take the Examiner's failure to address Applicants arguments as an indication that the Examiner agrees with Applicants' arguments.

IV.   CONCLUSION AND PRAYER FOR RELIEF

Based on the foregoing, it is respectfully submitted that the rejection of Claims 1-29 and 31 under 35 U.S.C. § 103(a) as being anticipated by Barry and Schwier lacks the requisite factual and legal bases. Appellants therefore respectfully request that the Honorable Board reverse the rejection of Claims 1-29 and 31 under 35 U.S.C. § 103(a) as being anticipated by Barry and Schwier.

Respectfully submitted,
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CLAIMS APPENDIX

1. (Previously Presented) A method comprising:

    receiving, at a merge utility executing on a computer system, a request to merge a first merge document in a merge format with a second document in an original format;

    wherein the second document was created in said original format by a first document authoring application;

    in response to the request, the merge utility causing the second document to be converted from the original format to the merge format to create a second merge document;

    wherein the second merge document is in the merge format;

    wherein the step of converting is performed by either the merge utility or the first document authoring application;

    the merge utility merging the first merge document and the second merge document to generate a composite merge document; and

    after generating the composite merge document, the merge utility causing said composite merge document to be delivered to an output device;

    wherein the output device is a device that is different from the computer system;

    wherein the original format is a format that is not supported by the output device, and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device; and

    wherein the merge format is a format that is supported by the output device, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device;

    wherein the method is performed by one or more computing devices.

2. (Original) The method of Claim 1 further comprising:

    generating the first merge document in said merge format by converting a first original document from an original format to the merge format.

3. (Original) The method of Claim1, wherein the merge format is Standard Printing and Imaging Format (SPIF).

4. (Original) The method of Claim 3, wherein the merge format is PDL Postscript.

5. (Original) The method of Claim 1, wherein the first document is a background template document and the second document is an overlay document.

6. (Previously Presented) The method of Claim 5,

      wherein the background template document is originally created by a second document
            authoring application; and

      wherein the second document authoring application is different from said first document
            authoring application.

7. (Original) The method of Claim 5, wherein the background template document is created in a second original format and converted from the second original format to the merge format.

8. (Previously Presented) The method of claim 1, wherein causing the second document to be converted from the original format to the merge format comprises the merge utility converting the second document to the merge format.

9. (Previously Presented) The method of Claim 1, wherein causing the second document to be converted from the original format to the merge format to create the second merge document includes:

      the merge utility generating, based on the original format, a set of conversion instructions
            to convert the second document into said second merge document;

      passing the set of conversion instructions from the merge utility to the first document
            authoring application;

      wherein the conversion instructions, when interpreted by the first document authoring
            application, cause the first document authoring application to generate the second
            merge document based on said set of conversion instructions.

10. (Previously Presented) The method of Claim 1, wherein the request contains information about the first document authoring application, wherein causing the second document to be converted from the original format to the merge format to create the second merge document includes:

> the merge utility generating, based on the information about the first document authoring application, a set of conversion instructions to convert the second document into said second merge document;

> passing the set of conversion instructions from the merge utility to the first document authoring application; and

> wherein the conversion instructions, when interpreted by the first document authoring application, cause the first document authoring application to generate the second merge document based on said set of conversion instructions.

11. (Original) The method of Claim 1, wherein the composite merge document is in the merge format.

12. (Original) The method of Claim 1, wherein the composite merge document is a template for creating other documents.

13. (Previously Presented) The method of Claim 1,

> wherein the steps of causing the second document to be converted and merging the first merge document and the second merge document are both performed in response to the merge utility receiving the request to merge documents.

14. (Previously Presented) The method of Claim 1 further comprising:

> generating the first merge document in said merge format by converting a first original document from an original format to the merge format;

> wherein the merge format is Standard Printing and Imaging Format (SPIF);

> wherein the first document is a background template document and the second document is an overlay document;

wherein the background template document is originally created by a second document
authoring application; and

wherein the second document authoring application is different from said first document
authoring application;

wherein the background template document is created in a second original format and
converted from the second original format to the merge format.

15. (Previously Presented) A machine-readable storage medium storing one or more sequences
of instructions, which when executed by one or more processors, causes:

receiving, at a merge utility executing on a computer system, a request to merge a first
merge document in a merge format with a second document in an original format;

wherein the second document was created in said original format by a first document
authoring application;

in response to the request, the merge utility causing the second document to be converted
from the original format to the merge format to create a second merge document;

wherein the second merge document is in the merge format;

wherein the step of converting is performed by either the merge utility or the first
document authoring application;

the merge utility merging the first merge document and the second merge document to
generate a composite merge document; and

after generating the composite merge document, the merge utility causing said composite
merge document to be delivered to an output device;

wherein the output device is a device that is different from the computer system;

wherein the original format is a format that is not supported by the output device, and
therefore needs to be converted to another format that is supported by the output
device in order to be properly interpreted by the output device; and

wherein the merge format is a format that is supported by the output device, and therefore
does not need to be converted to another format that is supported by the output
device in order to be properly interpreted by the output device.

16. (Previously Presented) The machine-readable storage medium of Claim 15, wherein the one or more sequences of instructions, when executed by one or more processors, further causes:

  generating the first merge document in said merge format by converting a first original document from an original format to the merge format.

17. (Previously Presented) The machine-readable storage medium of Claim 15 wherein the merge format is Standard Printing and Imaging Format (SPIF).

18. (Previously Presented) The machine-readable storage medium of Claim 17 wherein the merge format is PDL Postscript.

19. (Previously Presented) The machine-readable storage medium of Claim 15 wherein the first document is a background template document and the second document is an overlay document.

20. (Previously Presented) The machine-readable storage medium of Claim 19,

  wherein the background template document is originally created by a second document authoring application; and

  wherein the second document authoring application is different from said first document authoring application.

21. (Previously Presented) The machine-readable storage medium of Claim 19 wherein the background template document is created in a second original format and converted from the second original format to the merge format.

22. (Previously Presented) The machine-readable storage medium of Claim 15 wherein causing the second document to be converted from the original format to the merge format comprises the merge utility converting the second document to the merge format.

23. (Previously Presented) The machine-readable storage medium of Claim 15 wherein causing the second document to be converted from the original format to the merge format to create the second merge document includes:

the merge utility generating, based on the original format, a set of conversion instructions to convert the second document into said second merge document;

passing the set of conversion instructions from the merge utility to the first document authoring application;

wherein the conversion instructions, when interpreted by the first document authoring application, cause the first document authoring application to generate the second merge document based on said set of conversion instructions.

24. (Previously Presented) The machine-readable storage medium of Claim 15 wherein the request contains information about the first document authoring application, wherein causing the second document to be converted from the original format to the merge format to create the second merge document includes:

the merge utility generating, based on the information about the first document authoring application, a set of conversion instructions to convert the second document into said second merge document;

passing the set of conversion instructions from the merge utility to the first document authoring application; and

wherein the conversion instructions, when interpreted by the first document authoring application, cause the first document authoring application to generate the second merge document based on said set of conversion instructions.

25. (Previously Presented) The machine-readable storage medium of Claim 15 wherein the composite merge document is in the merge format.

26. (Previously Presented) The machine-readable storage medium of Claim 15 wherein the composite merge document is a template for creating other documents.

27. (Previously Presented) The machine-readable storage medium of Claim 15

wherein the steps of causing the second document to be converted and merging the first

    merge document and the second merge document are both performed in response

    to the merge utility receiving the request to merge documents.

28. (Previously Presented) The machine-readable storage medium of Claim 15 wherein the one or more sequences of instructions, when executed by one or more processors, further causes :

    generating the first merge document in said merge format by converting a first original

        document from an original format to the merge format;

    wherein the merge format is Standard Printing and Imaging Format (SPIF);

    wherein the first document is a background template document and the second document

        is an overlay document;

    wherein the background template document is originally created by a second document

        authoring application; and

    wherein the second document authoring application is different from said first document

        authoring application;

    wherein the background template document is created in a second original format and

        converted from the second original format to the merge format.

29. (Previously Presented) The method of Claim 1, wherein the first merge document is a version of a first document that has been converted from an original format to the merge format.

30.   (Canceled)

31. (Previously Presented) The machine-readable storage medium of Claim 15 wherein the first merge document is a version of a first document that has been converted from an original format to the merge format.

32. (Canceled)